



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,219	01/25/1999	DOUGLAS T. ROSENOFF	962.002US1	9491

21186 7590 05/23/2002

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

12/26

Office Action Summary

Application No.

09/237,219

Applicant(s)

ROSENOFF ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14, 15, 17 and 19-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14 -15, 17 and 19-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2176

DETAILED ACTION

1. This action is responsive to communications: amendment A filed 03/06/2002 to the application filed 01/25/1999.
2. Claims 1-9, 14-15, 17 and 19-49 are currently pending in this application. Claims 10-13, 16, and 18 have been cancelled; claims 19-49 have been added by Applicant. Claims 1- 6, 14 and 17 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-9, 14-15, 17 and 19-49 are rejected under 35 U.S.C. 102(e) as being anticipated by **Horowitz et al.** (U.S 6,122,647).

As to independent claim 1, Horowitz teaches a method of automatically inserting hyperlinks into a document (dynamically generates contextual hypertext links in a source document; col.2, lines 40-67), comprising:

- searching one or more documents (navigating HTML and other web content; col.7, lines 1-67) for content matching one or more predefined forms (links from a document to relevant other document; col. 3, lines 1-8);

- marking one or more portions of one or more of the documents (selects a portion of the source document; col.7, lines 1-67 & Fig.4b) based on results of searching the one or more documents (associated with the selected terms of the source document; col.7, lines 1-67); and

- generating one or more hyperlinks, with each hyperlink having a format based on the content of the one or more of the marked portions of the documents (links are dynamically generated, base on the content of the selected text col.3, lines 1-67; If there is more than one link for the tag, then a menu of links to target documents is created at the link anchor... with each link being named by a simplified title; col.10, lines 22-34).

As to dependent claim 19, Horowitz teaches the one or more predefined forms includes citations to printed publication (The meta-data may include items such as ...publication; col.6, lines 13-27).

As to dependent claim 20, Horowitz teaches one or more of the marked portions includes a citation to a document, the citation including a volume identifier, a page identifier, and publication identifier, and wherein at least one of the generated hyperlinks includes volume, page, and publication identifiers (The meta-data may include items such as document identifier, title, author, date, publication, industry codes...Each document also has a network location, preferably specified as a uniform resource locator; col.6, lines 13-27).

As to dependent claim 21, Horowitz teaches one or more of the generated hyperlinks includes at least one query connector (the information retrieval system 100 including receiving user input queries; col.5, lines 43-48).

As to dependent claim 22, Horowitz teaches one or more of the generated hyperlinks further includes at least one search instruction (Each document also has a network location, preferably specified as a uniform resource locator (URL) for accessing documents using the HyperText Transport Protocol (HTTP); col.6, lines 13-27).

As to dependent claim 23, Horowitz teaches one or more of the generated hyperlinks further includes a search-method identifier (document identifier; col.6, lines 13-27).

As to dependent claim 24, Horowitz teaches the search-method identifier identifies one of a natural-language search method and a Boolean search method (links are generated in response...command at the time the resource document is accessed; col.2, lines 62-67).

As to dependent claim 25, Horowitz teaches one or more of the generated hyperlinks further includes account information for a user (The meta-data; col.6, lines 13-27).

As to dependent claim 26, Horowitz teaches one or more of the generated hyperlinks further includes information identifying a third-party sponsor for facilitating access to a document in a database associated with the one hyperlink (target documents are identified, preferably using a database which associates the terms with topics; col.12, lines 24-37).

As to dependent claim 27, Horowitz teaches associating at least one of the generated hyperlinks with at least one of the marked portions (The links may be added directly in the text of the selected portion; col.10, lines 22-34).

As to dependent claim 28, Horowitz teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes associating at least one of the generated hyperlinks with at least two of the marked portions (if there is more than one link for the tag, then a menu of links to target documents is created at the link anchor... with each link being named by a simplified title; col.10, lines 22-34).

As to dependent claim 41, Horowitz teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes anchoring at least one of the generated hyperlinks to at least one of the marked portions (The links may be added directly in the text of the selected portion... if there is more than one link for the tag, then a menu of links to target documents is created at the link anchor... with each link being named by a simplified title; col.10, lines 22-34).

Independent claim 2, the rejection of independent claim 1 above, is incorporated herein in full.

Independent claim 3 is directed to a computer system presenting the method of the claim 1, and is similarly rejected under the same rationale.

Independent claim 4 is for a computer system presenting the method of the claim 1, and is similarly rejected under the same rationale.

However, claim 4 further recites:

- a processor;
- a memory coupled to the processor,

Horowitz teaches:

- a processor (a processor; col.5, lines 25-33);
- a memory (addressable memory; col.5, lines 25-33) coupled to the processor,

Independent claim 5 is directed to a computer-readable medium for performing the method of claim 1, and is similarly rejected under the same rationale.

As to independent claim 6, Horowitz teaches an automated method of defining hyperlinks for a document (dynamically generates contextual hypertext links in a source document to other topically relevant documents; col.2, lines 40-67), comprising:

- marking one or more portions of the document (selects a portion of the source document; col.7, lines 1-67 & Fig.4b); and

- defining one or more hyperlinks for one or more of the marked portions of the document (the dynamic generation of context links by selecting a portion of the target document; col.11, lines 1-67), with each hyperlink including at least a portion of one of the marked portions of the document (each document has a URL; col.3, lines 37-60).

As to dependent claim 7, Horowitz teaches each hyperlink further includes account information for a user ((The meta-data; col.6, lines 13-27).

As to dependent claim 8, Horowitz teaches each hyperlink includes a domain name common to all the hyperlinks (figs 4a-4d).

As to dependent claim 9, Horowitz teaches each hyperlink includes a domain name common to all the hyperlinks and information based on a syntactic or semantic analysis of at least a portion of one of the marked portions of the document (Topic analysis may be determined by various syntactic and semantic processes; col.3, lines 24-36, and col.8, lines 39-49).

As to independent claim 14, Horowitz teaches a method of defining a hyperlink (dynamically generates contextual hypertext links in a source document to other topically relevant documents; col.2, lines 42-67) in a computer system, comprising:

Art Unit: 2176

- providing one or more user preferences (receiving user input queries...receiving user selections of portions of any displayed document; col.5, lines 43-55).

- marking a portion of a first document (selected portion of source document; col.3, lines 61-67 & Fig.4b)

- defining a hyperlink to point to one of at least two or more destinations based on one or more of the provided user preferences (The links may be added directly in the text of the selected portion...If there is more than one link for the tag, then a menu of links to target documents is created at the link anchor... with each link being named by a simplified title; col.10, lines 22-34).

As to dependent claim 15, Horowitz teaches providing one or more user preferences includes retrieving information related to one or more preferred hyperlink destinations, or information related to cost, or information related to access time; and defining the hyperlink includes selecting the one destination based on the retrieved preferences (The meta-data may include items such as document identifier, title, author, date, publication, industry codes...Each document also has a network location, preferably specified as a uniform resource locator; col.6, lines 13-27).

As to dependent claim 29, Horowitz teaches providing one or more user preferences includes retrieving information related to cost; and defining the hyperlinks including selecting the one destination based on cost (the information retrieval system; col.5, lines 34-55).

As to dependent claim 30, Horowitz teaches providing one or more user preferences includes retrieving information related to access time; and defining the hyperlinks including selecting the one destination based on access time (the information retrieval system; col.5, lines 34-55).

As to dependent claim 31, Horowitz teaches one of two or more destination is within the computer system and another of the two or more destination is without the computer system (The presentation module 150 is responsible for determining a set of target documents associated with the generated tags in a document, and constructing a set of hypertext links to the target documents; col.6, lines 49-59).

Dependent claim 32-34 and 35 include the limitations as in claims 20-22 and 47, and are similarly rejected under the same rationale.

Dependent claims 36-37 and 38 include the limitations as in claims 25-26 and 28, and are similarly rejected under the same rationale.

As to independent claim 17, Horowitz teaches a method of automatically inserting hyperlinks into a document (dynamically generates contextual hypertext links in a source document; col.2, lines 40-67), comprising:

- searching one or more documents (navigating HTML and other web content; col.7, lines 1-67);
- marking one or more portions of one or more of the documents (selects a portion of the source document; col.7, lines 1-67 & Fig.4b) based on results of searching the one or more documents (associated with the selected terms of the source document; col.7, lines 1-67); and
- generating one or more hyperlinks (new links are embedded directly in the text of the source document; col.7, lines 19-31 & Fig.4c) with each hyperlink including at least portion of the one of the marked portions (The links may be added directly in the text of the selected portion; col.10, lines 21-28).

Art Unit: 2176

As to dependent claim 39, Horowitz teaches associating at least one of the generated hyperlinks with at least one of the marked portions (The links may be added directly in the text of the selected portion; col.10, lines 21-28).

As to dependent claim 40, Horowitz teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes associating at least of the generated hyperlinks with at least two of the marked portions (The links may be added directly in the text of the selected portion...If there is more than one link for the tag, then a menu of links to target documents is created at the link anchor... with each link being named by a simplified title; col.10, lines 22-34).

As to dependent claim 42, Horowitz teaches searching the one or more documents comprises searching for citations to other documents (search engines... dynamically generates contextual hypertext links in a source document to other topically relevant documents; col.2, lines 41-51).

As to dependent claim 43, includes the same limitations as in claim 42, and is similarly rejected under the same rationale.

As to dependent claim 44, “ searching the one or more documents comprises searching for proper names” is inherent to the system of Horowitz.

Dependent claims 45 and 46, include the limitations as in claims 32 and 21, and are similarly rejected under the same rationale.

Dependent claim 47, includes the same limitations as in claim 35, and is similarly rejected under the same rationale.

Dependent claims 48-49 include the same limitations as in claims 25-26, and are similarly rejected under the same rationale.

Response to Arguments

4. Applicant's arguments filed 01/25/1999 have been fully considered but they are not persuasive.

The broad claim language used to continues to read the reference presented in the previous office action.

Applicant argues "*Regarding claims 1-3, Horowitz fails ...for searching one or more documents for content matching one or more predefined forms and making one or more portions of one or more of the documents based on results of searching the one or more documents*" (Amendment; pages 20, lines 22-25).

In response, Horowitz does teach: *searching one or more documents (navigating HTML and other web content; col.7, lines 1-67) for content matching one or more predefined forms (links from a document to relevant other document; col. 3, lines 1-8); marking one or more portions of one or more of the documents (selects a portion of the source document; col.7, lines 1-67 & Fig.4b) based on results of searching the one or more documents (associated with the selected terms of the source document; col.7, lines 1-67)* as broadly recited by Applicant.

Applicant argues " *Horowitz fails to choose among multiple destinations in defining its hyperlinks* " (Amendment; pages 22, lines 19-25).

In response, Horowitz's teachings "*The links may be added directly in the text of the selected portion...If there is more than one link for the tag, then a menu of links to target documents is created*

Art Unit: 2176

at the link anchor... with each link being named by a simplified title;" (col.10, lines 22-34) do read-on the limitations as claimed by Applicant.

As to added claims 19-49, note the rejection above.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 8:30am – 6:00 pm. The Examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for

Art Unit: 2176

the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

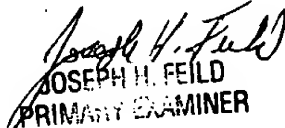
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.
OFFICIAL faxes must be signed and sent to (703) 746-7239.
NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.


JOSEPH H. FEILD
PRIMARY EXAMINER